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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,219	10/15/2003	Calvin Wang	021756-002700US	8072
51206 7590 09/25/2007 TOWNSEND AND TOWNSEND AND CREW LLP TWO EMBARCADERO CENTER 8TH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER MOUZON, LAJUANIA N	
			ART UNIT 2153	PAPER NUMBER
			MAIL DATE 09/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/687,219

Applicant(s)

WANG ET AL.

Examiner

La Juania N. Mouzon

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office Action is in response to Applicant's Amendment filed 6/27/2007.

Claims 1-25 are pending.

Drawings

2. Applicant's amendments to the drawings filed on 6/27/2007, have been fully considered and are persuasive. The objections to the drawings have been withdrawn.

Specification

3. Applicant's amendments to the specification filed on 6/27/2007, have been fully considered and are persuasive. The objections to the specification have been withdrawn.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3-8, 11-17, 19,22, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Kikinis (US 5,38,252).

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6. In regards to claim 1 Kikinis discloses, a method for messaging with devices in order to determine one or more actions to perform, the method comprising:

- a. storing information for a message, the stored information comprising action information corresponding to the one or more actions (**Col. 4 line(s) 17-27, teach that the information for a message is stored with the appropriate actions.**);
- b. sending a message to a device including a message identifier and one or more action identifiers corresponding to the one or more actions (**Col. 4 line(s) 28-36, teach sending a message to a device with a message identifier (ex. Stock A) and an action identifiers (ex. "Sell 100", "Sell 1000") linked to a variety of actions.**);
- c. receiving a response message from the device, the response message including an action identifier in the one or more action identifiers and the message identifier (**Col. 4 line(s) 38-42, teach a broker receiving a message identifying the action(s) and the user (message identifier) would like to take.**);
- d. determining the stored information using the message identifier (**Col. 4 line(s) 38-42, teach based off of the programming of the server (as described in Col. 4 line(s) 17-27), the message identifier (ex. Stock A) is used to determine the stored information.**);
- e. determining action information in the stored information corresponding to an action in the one or more actions using the action identifier (**Col. 4 line(s) 38-**

42, teach based off of the programming of the server (as described in Col. 4 line(s) 17-27) the determining of the action information corresponds to an action using the action identifier.);

f. and performing the action using the action information (**Col. 4 line(s) 38-42, teach performing the action using the action information.**).

7. In regards to claim 3 Kikinis discloses, wherein the sent message comprises a text-based message and the response message comprises a text-based message (**Fig. 3B, displays that the sent message and response message is a text-based message.**).

8. In regards to claims 4 and 14 Kikinis discloses, sending a result of the performed action to the device (**Col. 2 line(s) 66-67, teach sending the results of the action to the device.**).

9. In regards to claim 5 Kikinis discloses, determining device information associated with the response message, wherein the message identifier and the device information are used to determine the stored information (**Col. 4 line(s) 19-26, teach that the server is programmed to associate the response message with device information entered in by the user and the message identifier and the device information are used to determine the stored information.**)

10. In regards to claim 6 Kikinis discloses, wherein the device information comprises at least one of information specific to a device and information specific to a user (**Col. 4**

line(s) 19-26, teach the user configuring a server with device information (ex. Pager number) and specific information (ex. Stock A, Stock B) that the user would like to receive messages for.).

11. In regards to claim 7 Kikinis discloses, wherein the device comprises a mobile device **(Fig. 1 #138, displays the device as a pages, which is a mobile device.).**

12. In regards to claim 8 Kikinis discloses, a method for messaging with devices in order to determine one or more actions to perform, the method comprising:

g. storing information on how to perform one or more actions **(Col. 4 line(s) 16-26, teach the user storing information on how each action should be performed.);**

h. sending a message to a device including information identifying the one or more actions **(Col. 4 line(s) 28-36 and Col. 2 line(s) 60-62, teach sending a message to a device with selectable an actions.);**

i. receiving a text message from the device including information identifying a desired action in the one or more actions **(Col. 4 line(s) 38-42, teach a broker receiving a text message identifying the action(s) and the user (message identifier) would like to take.);**

j. determining stored information on how to perform the desired action using the information specifying the desired action **(Col. 4 line(s) 38-42, teach based off of the programming of the server (as described in Col. 4 line(s) 17-27) the determining of the stored information on how to perform the action.),**

k. and causing the determined action to be performed using the information on how to perform the desired action (**Col. 4 line(s) 40-42, teach that performing the action using the action information on how to perform it.**).

13. In regards to claim 11 Kikinis discloses, wherein the sent message comprises a plain-text message (**Fig. 3B, displays that the sent message is a plain-text message.**).

14. In regards to claim 12 Kikinis discloses, wherein the text message comprises a plain-text message (**Fig. 3B, displays wherein the text message comprising a plain-text message.**).

15. In regards to claim 13 Kikinis discloses, wherein determining the stored information comprises using a message identifier for the received message to determine the stored information (**Col. 4 line(s) 19-26, teach that the message identifier are preprogrammed variables in which are used to determined the stored information for the received message.**).

16. In regards to claim 15 Kikinis discloses, device for generating and processing messages to determine actions to perform, the device comprising: a message generator configured to generate a message identifying one or more actions and to send the generated message to a device; an information storer configured to store information associated with the identified one or more actions; a receiver configured to receive a response message from the device, wherein the response message identifies an action

in the one or more actions identified in the message sent to the device; an action determiner configured to determine stored information for the identified action; and an action performer configured to cause the action to be performed using the determined stored information (**Fig. 1 #130, Col. 4 line(s) 17-42, and as disclosed above, teaches that the server is made up of all the components above in claim 15. The server is able to send messages (message generator), store information (information storer), receive messages (receiver) and determine and perform actions (action determiner & performer).).**

17. In regards to claim 16 Kikinis discloses, wherein the generated message comprises a text message (**Fig. 3B, displays that the sent message is a text message.).**

18. In regards to claim 17 Kikinis discloses, wherein the response message comprises a text message (**Fig. 3B, displays that the response message comprises a text message.).**

19. In regards to claim 19 Kikinis discloses, wherein the action determiner determines the stored information using at least one of a message identifier for the response message to and information specific to the response message (**Col. 4 line(s) 19-26, teach that the action determiner (server) is programmed with message identifier that are preprogrammed variables in which are used to determined the stored information when receiving a response message.).**

20. In regards to claim 20 Kikinis discloses, wherein the information specific to the response message comprises information specific to a user (**Col. 4 line(s) 22-27, teach that the information is specific to the user as referenced to the sender.**).

21. In regards to claim 21 Kikinis discloses, system configured to perform actionable messaging, the system comprising:

- l. one or more devices (**Fig. 1, displays a plurality of devices.**);
- m. an application configured to perform actions (**Fig. 1 and Col. 4 line(s) 12-21, teach the stock service, as implemented in the server, as being the application that is able to perform actions by notifying the subscriber.**);
- n. and an actionable message device configured to communication with the one or more devices and the application (**Fig. 1, teach the server receiving actions and sending messages to multiple devices and the application (stock and news service).**), the device comprising:
 - i. a message generator configured to generate a message identifying one or more actions and to send the generated message to a device; an information storer configured to store information associated with the identified one or more actions; a receiver configured to receive a response message from the device, wherein the response message identifies an action in the one or more actions identified in the message sent to the device; an action determiner configured to determine stored information for the identified action; and an action performer configured to cause the action to be performed using the determined stored information (**Fig. 1**

#130, as disclosed above, teaches that the server is made up of all the components above in claim 15. The server is able to send messages (message generator), store information (information storer), receive messages (receiver) and determine and perform actions (action determiner & performer).).

22. In regards to claim 22 Kikinis discloses, wherein the one or more devices comprise mobile devices **(Fig. 1 #138, displays the device as a pages, which is a mobile device.).**

23. In regards to claim 25 Kikinis discloses, wherein the application comprises a web-based application **(Fig. 1, displays whereas the application is a web-based application by it being linked to the internet.).**

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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25. Claims 2, 9, 10, 18, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis (US 5,838,252) as applied to claims 1, 8, 15, and 21 above, and further in view of Gifford et al. (US 6,549,612).

26. In regards to claim 2 Kikinis does not teach, wherein the action information comprises information compatible with a web-based application, wherein the web-based application is used to perform the action.

27. In the same field of endeavor Gifford et al. teach sending messages with selectable actions wherein the information for those actions are compatible with web-based applications and the selected actions are able to perform on these applications (Col. 50-59).

28. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis interactive two-way pager systems with Giggord et al. teaching as discussed above to allow for the capability of sending an enriched email to provide a user with an interface to access and/or control of a variety of online services.

29. In regards to claim 9 Kikinis does not teach, wherein the information on how to perform the one or more actions comprises web-based information.

30. In the same field of endeavor Gifford et al. teach sending messages with selectable actions wherein the information on how to perform the actions are obviously comprises web-based information by the use of using hyperlinks that uses embedded code that is recognized by the web to perform the actions **(Col. 4 line(s) 50-55)**.

31. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis interactive two-way pager systems with Giggord et al. teaching as discussed above to allow for the capability of sending an enriched email to provide a user with an interface to access and/or control of a variety of online services.

32. In regards to claim 10 Kikinis does not teach, wherein the web-based information comprises a URL.

33. In the same field of endeavor Gifford et al. teach sending messages with selectable actions wherein the information on how to perform the actions are obviously comprises web-based information by the use of using hyperlinks (URLs) that uses embedded code that is recognized by the web to perform the actions **(Col. 4 line(s) 50-55)**.

34. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis interactive two-way pager systems with

Giggord et al. teaching as discussed above to allow for the capability of having an URLs in the web-based information for directing the user to the correct web location.

35. In regards to claim 18 Kikinis does not teach, wherein the one or more actions comprise web-based actions.

36. In the same field of endeavor Gifford et al. teach sending messages with selectable actions and using an interface that allows for the actions to be web-based **(Col. 4 line(s) 55-59).**

37. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis interactive two-way pager systems with Giggord et al. teaching as discussed above to allow for the capability of using the client to perform web-based actions in order to request other information which can be displayed in a dynamically generated HTML/XML/WML page.

38. In regards to claim 23 Kikinis do not teach, wherein the mobile devices are configured to receive messages exclusive of web-based messages.

39. In the same field of endeavor Gifford et al. teach sending messages with selectable actions when in the devices receiving these message can be configured to receive web-based messages only, as displayed in Fig. 3.

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40. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis interactive two-way pager systems with Giggord et al. teaching as discussed above to allow for the capability of receiving information in that can be constructed from at least one dynamic source.

41. In regards to claim 24 Kikinis do not teach, wherein the mobile devices are configured to send messages exclusive of web-based messages.

42. In the same field of endeavor Gifford et al. teach sending messages with selectable actions when in the devices can be configured to send web-based messages only, as displayed in Fig. 3.

43. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kikinis interactive two-way pager systems with Giggord et al. teaching as discussed above to allow for the capability of sending information in that can be constructed from at least one dynamic source.

Response to Arguments

44. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

45. Applicant's arguments, see pg. 10, filed 6/27/2007, with respect to the 112 Second paragraph rejection have been fully considered and are persuasive. The rejection of claim 6 has been withdrawn.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to La Juania N. Mouzon whose telephone number is 571-270-3045. The examiner can normally be reached on Monday - Friday 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LNLM


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